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EXAMINER	
DARNO, PATRICK A	

ART UNIT	PAPER NUMBER
2163	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/728,879	LEE, EUGENE M.	
	Examiner	Art Unit	
	Patrick A. Darno	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08162006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-13 have been cancelled. Claims 14-31 are pending in this office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 14-31 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.

With respect to claim 14, the claim is rejected under 35 U.S.C. 101 because the invention, as claimed, appears to be directed to merely an abstract idea. The Examiner makes this assertion because the claim simply recites designating a field or search, generating a list of words, entering search criteria, an determining search able elements with no attempt to tie all of the methods steps together in order to carry out a final, conclusionary tangible method step. Since the claim presented by the applicant is simply a representation of an abstract idea, the claims are not covered by the statutory categories of patentable subject matter set forth in 35 U.S.C. 101. JB 12-11-06

However, an abstract idea is categorized as one of three judicially created exceptions to patentable subject matter (the three exceptions are Laws of Nature, Natural Phenomena, and Abstract Ideas). The courts have concluded that in order to patent one of the three judicial exceptions to the statutory categories of invention the applicant must show that the claimed invention has a practical, real-world application that produces a useful, concrete, and tangible result *(State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02).*

In order to overcome this rejection, it is required that the Applicant amend claim 14 such that claim 14 provides a final, conclusionary step. This final step should tie together all previously recited method steps. Finally, the claimed invention as a whole must set forth a practical application of the invention, which provides a useful, concrete, and tangible result. The Examiner would favorably consider an amendment which recites language directed to actually constructing a query based on the lists of words entered and generated in steps (a) – (d), executing a query, and then receiving results returned from the execution of the query. However, the Applicant is free to develop his/her own amendment in order to make the claims patentable under 35 U.S.C. 101. Correction of this deficiency is required.

JS 12-11-06

Claims 15-22 are rejected because they fail to correct the deficiency that arises in claim 14.

JS 12-11-06

Claim 23 is directed to an article of manufacture containing a computer readable medium. A computer program is classified as an abstract idea. Since claim 23 is directed to an abstract idea, it is rejected under the same reasons set forth in the rejection of claim 14 See rejection of claim 14 for a suggestion as to how to amend the claim such that the claim can become patentable under 35 U.S.C. 101.

JS 12-11-06

Claims 24-31 are rejected because they fail to correct the deficiency that arises in claim 23.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 14-16, 18-20, 23-26, and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication Number 2004/0024739 issued to Max Copperman et al. (hereinafter "Copperman").

Claim 14:

Copperman discloses a method of utilizing an intellectual property thesaurus, the method comprising:

(a) designating a field of search based on selection of at least one of a plurality of classifications of an intellectual property classification system *(Copperman: paragraph [0059] – paragraph [0061] and paragraph [0154], lines 1-8; In the first reference cited ([0059] – [0061]), Copperman clearly discloses a system which stores intellectual property documents which are classified by use of a taxonomy. Surely a system, which stores classified intellectual property, is an 'intellectual property classification system'. The second reference cited clearly discloses the user selecting specific classifications (taxonomies and concept nodes) of documents. As noted above, the documents can include intellectual property documents.)*;

(b) generating a list of words found in intellectual property information classified in the field of search designated in said designating step (a) *(Copperman: paragraph [0008], lines 9-12 and paragraph [0075])*;

(c) entering search criteria utilizing keywords *(Copperman: paragraph [0154], lines 1-8)*; and

(d) determining searchable elements related to keywords in the search criteria based on the list of words generated in said generating step (b) *(Copperman: paragraph [0162])*.

Claim 15:

Copperman discloses all the elements of claim 14, as noted above, and Copperman further discloses wherein said generating step (b) further comprises the step of determining a frequency of occurrence of each listed word found in the intellectual property information associated with the field of search *(Copperman: paragraph [0082], lines 8-16 and paragraph [0122], lines 39-45).*

Claim 16:

Copperman discloses all the elements of claim 15, as noted above, and Copperman further discloses:

(e) displaying, in the form of a word-frequency list, the list of words found in the intellectual property information classified in the field of search, wherein each listed word is associated with a corresponding frequency of occurrence of the listed word *(Copperman: paragraph [0122], lines 39-45 and paragraph [0122], lines 55-57; Note specifically that the terms (for which word frequencies were determined) are presented (displayed) to a user.).*

Claim 18:

Copperman discloses all the elements of claim 14, as noted above, and Copperman further discloses wherein said entering step (c) comprises entering keywords that formulate a search query *(Copperman: paragraph [0154], lines 1-8)*; and wherein said determining step (d) comprises:

determining searchable elements related to select keywords in the search query by locating words on the list generated in said generating step (b) that are synonyms of select keywords in the search query *(Copperman: paragraph [0162], lines 1-6)*; and

storing the synonyms thus determined in an accrued synonym list corresponding to the select keyword in the search query *(Copperman: paragraph [0162]).*

Claim 19:

Copperman discloses all the elements of claim 18, as noted above, and Copperman further discloses wherein said determining step (d) is automatically preformed to determine synonyms for keywords in the search query *(Copperman: paragraph [0162], lines 1-6; Note specifically that the search query is actually 'performed'.).*

Claim 20:

Copperman discloses all the elements of claim 18, as noted above, and Copperman further discloses wherein said step (c) further comprises the step of automatically incorporating into the search criteria synonyms form the accrued synonym list *(Copperman: paragraph [0162], lines 1-6).*

Claim 23:

Copperman discloses in a search system for use in searching for intellectual property information, the improvement comprising an article of manufacture having stored thereon an executable program operative to effectuate searching for intellectual property information in connection with the search system, wherein the executable program is executed to perform the steps of:

(a) designating a source grouping comprising at least one document having intellectual property information *(Copperman: paragraph [0059] – paragraph [0061] and paragraph [0154], lines 1-8; See rejection of claim 14 for further comments on these references.)*;

(b) generating a list of words found in the at least one document in the intellectual property information within the source grouping designated in said designating step (a) *(Copperman: paragraph [0008], lines 9-12 and paragraph [0075])*; and providing at least a portion of the elements in the list for later use as search criteria *(Copperman: paragraph [0162])*.

Claim 24:

All the limitations of claim 24 were clearly addressed in the rejection of claim 18. Claim 24 is rejected under the same reasons set forth in the rejection of claim 18.

Claim 25:

All the limitations of claim 25 were clearly addressed in the rejection of claim 18. Claim 25 is rejected under the same reasons set forth in the rejection of claim 18.

Claim 26:

Copperman discloses all the elements of claim 25, as noted above, and Copperman further discloses wherein said designating step (a) further comprises:

receiving input signals from a user containing a selection of at least one of a plurality of classifications of an intellectual property classification system; and designating the source grouping as a field of search based on the input selection from the user *(Copperman: paragraph [0059] – paragraph [0061] and paragraph [0154], lines 1-8; In the first reference cited ([0059] – [0061]), Copperman clearly discloses a system which stores intellectual property documents which are classified by use of a taxonomy. Surely a system, which stores classified intellectual property, is an 'intellectual property classification system'. The second reference cited clearly discloses the user selecting specific classifications (taxonomies and concept nodes) of documents. As noted above, the documents can include intellectual property documents.)*.

Claim 28:

Copperman discloses all the elements of claim 25, as noted above, and Copperman further discloses wherein the source grouping includes selected intellectual property information stored in a database *(Copperman: paragraph [0059] – [0061])*, and wherein said generating step (b) includes the step of retrieving the selected intellectual property information from the database and compiling the list of words found in the retrieved intellectual property information *(Copperman: paragraph [0008], lines 9-12 and paragraph [0075])*.

Claim 29:

All the limitations of claim 29 were clearly addressed in the rejection of claim 20. Claim 29 is rejected under the same reasons set forth in the rejection of claim 20.

Claim 30:

Copperman discloses all the elements of claim 29, as noted above, and Copperman further discloses wherein the executable program further comprises the step of:

outputting the search criteria to a user interface *(Copperman: paragraph [0156], lines 3-5; Note specifically that the search engine 'returns documents' to a user.)*; and

accessing at least one remote database unit for intellectual property information corresponding to the search criteria *(Copperman: paragraph [0037] and paragraph [0042] and paragraph [0059] – [0061] and paragraph [0162], lines 1-6; The first two references clearly show that the search queries are intended to be executed remotely over a network in specifying that the invention is an 'e-service portal' and further specifying that the invention can be implemented in a client-server arrangement.)*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 17, 21-22, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman and further in view of U.S. Patent Application Publication Number 2004/0230574 issued to Alexander N. Kravets (hereinafter "Kravets").

Claim 17:

Copperman discloses all the elements of claim 16, as noted above, and Copperman further discloses the display of the word-frequency list *(Copperman: paragraph [0122], lines 39-45 and paragraph [0122], lines 55-57).*

Copperman does not explicitly disclose wherein said displaying step (e) comprises simultaneous display of the search criteria during operation of said entering step (c). However, Kravets discloses wherein said displaying step (e) comprises simultaneous display of the search criteria during operation of said entering step (c) and the display of the word-frequency list *(Kravets: paragraph [0044], lines 1-15 and Fig. 6, 300 and Fig. 8, 320).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Copperman with the teachings of Kravets noted above for the purpose of displaying both the user's input query and suggested search terms based upon a word-frequency list simultaneously *(Kravets: [0044]).* The skilled artisan would have been motivated to improve the teachings of Copperman per the above such that predicted or suggested

search terms are presented to the user in order to aid the user in locating the best search results *(Kravets: paragraph [0044], lines 9-15).*

Claim 21:

The combination of Copperman and Kravets discloses all the elements of claim 17, as noted above, and Copperman further discloses wherein utilizing an intellectual property thesaurus further comprises:

(f) submitting the search criteria as a search query to the database *(Copperman: paragraph [0162], lines 1-6; When the search query is 'performed', the search query is submitted to a database.).*

Claim 22:

The combination of Copperman and Kravets discloses all the elements of claim 21, as noted above, and Copperman further discloses wherein said submitting step (f) includes transmission of the search query to a remote database over the Internet *(Copperman: paragraph [0037] and paragraph [0042] and paragraph [0162], lines 1-6; The first two references clearly show that the search queries are intended to be executed remotely over a network in specifying that the invention is an 'e-service portal' and further specifying that the invention can be implemented in a client-server arrangement.).*

Claim 31:

Claim 31 is rejected under the same reasons set forth in the rejection of claim 17.

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman and further in view of U.S. Patent Number 5,991,751 issued Kevin G. Rivette et al. (hereinafter "Rivette").

Claim 27:

Copperman discloses all the elements of claim 26, as noted above, but Copperman does not explicitly disclose wherein the classification system is the system used by the U.S. Patent and Trademark Office for classification of patents, and wherein the input signals contain a selection of a plurality of classes and subclasses that form the source grouping.

However, Rivette discloses wherein the classification system is the system used by the U.S. Patent and Trademark Office for the classification of patents *(Rivette: column 17, lines 55-66)*, and wherein the input signals contain a selection of a plurality of classes and subclasses that form the source grouping *(Rivette: Fig. 57, 5718-5722)*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Copperman with the teachings of Rivette noted above. The skilled artisan would have been motivated to improve the teachings of Copperman per the above such that a user could easily identify patents that satisfy a specified key word search criteria *(Rivette: column 2, lines 25-26)*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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